

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Tetsuya Sugimoto

Application No.: 10/051,055

Filing Date: January 22, 2002

Group Art Unit: 2673

Examiner: Tom V. Sheng

Confirmation No.: 1789

Title: INPUT DATA PROCESSING DEVICE, DATA PROCESSING METHOD AND COMPUTER PROGRAM  
PRODUCT EXCELLENT IN GRAPHICAL USER INTERFACE FUNCTION AND VERSATILITY

AMENDMENT/REPLY TRANSMITTAL LETTER

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JUL 01 2004

Technology Center 2600

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per  
Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the  
☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.  
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted \_\_\_\_\_  
\_\_\_\_\_  
on \_\_\_\_\_  
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least \_\_\_\_\_,  
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.  
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also  
enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

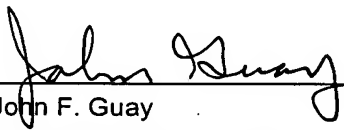
AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims	21	MINUS 21 =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims	3	MINUS 3 =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
<b>TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT</b>					<b>\$ 0.00</b>

- ☐ A check in the amount of \_\_\_\_\_ is enclosed for the fee due.
- ☐ Charge \_\_\_\_\_ to Deposit Account No. 02-4800.
- ☐ Charge \_\_\_\_\_ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By   
 John F. Guay  
 Registration No. 47,248

Date: June 29, 2004



Patent  
Attorney's Docket No. 009683-393

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>Mail Stop Non-Fee Amendment</b>
	)	
Tetsuya SUGIMOTO	)	Group Art Unit: 2673
	)	
Application No.: 10/051,055	)	Examiner: T. V. Sheng
	)	
Filed: January 22, 2002	)	Confirmation No.: 1789
	)	
For: INPUT DATA PROCESSING	)	
DEVICE, DATA PROCESSING	)	
METHOD AND COMPUTER	)	
PROGRAM PRODUCT EXCELLENT	)	
IN GRAPHICAL USER INTERFACE	)	
FUNCTION AND VERSATILITY	)	

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JUL 01 2004

Technology Center 2600

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Official Action dated April 6, 2004, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims.

In the most recent Office Action, all pending claims 1-21 were rejected under 35 U.S.C. § 103 as allegedly being obvious over U.S. Patent No. 5,045,880 to Evanitsky et al. in view of U.S. Patent No. 5,534,917 to MacDougall. This rejection is respectfully traversed.

One criterion that must be met to establish a *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all the claim limitations. See MPEP § 2143. It is respectfully submitted that the proposed combination of the Evanitsky et al. and MacDougall patents fails to meet this requirement because it does not teach or suggest the combination of each and every claimed feature recited in independent claims 1, 8 and 13, and hence also in their respective dependent claims.

With respect to claim 1, the Office Action correctly acknowledges that the Evanitsky et al. patent fails to teach the claimed memory unit storing bit map data corresponding to said

display image data and that the bit map data include data corresponding to respective positions of a plurality of input regions to which different values are assigned, respectively. The Office Action also correctly acknowledges, at page 3, lines 7-10, that Evanitsky et al. fails to teach or suggest outputting a value according to the bit map data as claimed.

Before proceeding with an analysis of why these claimed features are not taught or suggested in any applied reference, it should be noted that the Examiner makes the following statement concerning the Evanitsky et al. patent: "Inherently, a value or some other indication is communicated to the controller 114 in order to facilitate the tray selection." (Page 3, lines 1-2.) In response, Applicant respectfully disputes any allegation that the Evanitsky et al. patent inherently discloses "different values" in the context in which this feature is recited in independent claim 1. Indeed, an inherent disclosure of some thing requires that the missing descriptive matter of that thing is *necessarily* present in the prior art. See MPEP § 2112. Hence, the assertion in the Office Action articulated in the alternative (i.e., "a value *or* some other indication") cannot serve as a basis for an *inherent* disclosure in Evanitsky et al. of the claimed different respectively assigned values.

The Action goes on to state: "Evanitsky's user interface 213, including the touch input system 226 reads on [sic] claimed output portion for outputting a value corresponding to the designated position detected by said position detecting portion." (Page 3, lines 2-4.) However, because the claimed different values assigned respectively are not disclosed in the Evanitsky et al. patent, it follows that Evanitsky et al. does not teach the claimed "output portion for outputting *the value* corresponding to the designated position ...."

The MacDougall patent does not make up for the shortcomings of Evanitsky et al. noted above. The cited parts of MacDougall describe a bitmap 302 representing an area of interest 300, and each pixel of the bitmap 302 is assigned a value associated with an X and Y co-ordinate found in a look-up table 304. (See column 13, lines 22-25.) More particularly, Figures 11 and 12 of MacDougall show that each X and Y co-ordinate of each pixel the bitmap 302 of area of interest 300 is assigned a different value (i.e., each of thirteen pixels is respectively assigned one of values 0 to 12). It is respectfully submitted that this disclosure in the MacDougall patent of *one* region having a *plurality* of different values is contrary to the claimed "input regions to which different values are assigned respectively."

As pointed out above, neither the Evanitsky et al. patent nor the MacDougall patent teaches “input regions to which different values are assigned respectively,” as set forth in claim 1. Even if one were, for the sake of argument, motivated to somehow combine the teachings of these documents, such hypothetical combination would not have taught or suggested the claimed combination of features. For instance, such hypothetical combination would perhaps have led one of ordinary skill in the art to include a “movable” area of interest in the display of Evanitsky et al., and a bit map corresponding to the area of interest including pixels, each having a *different* value assigned thereto. It would not, however, have taught bit map data set forth in claim 1, which include data corresponding to respective positions each of a plurality of input regions to which different values are assigned respectively. Moreover, it would appear that one of ordinary skill in the art would not have been motivated to have an icon displayed on the display of Evanitsky et al. move when attempting to select it.

Furthermore, it is respectfully submitted that the statements on page 3, lines 14-20 of the Office Action alleging what an artisan *would realize* and what *could be* done are based on conjecture and not on objective teachings of the applied documents. That is, whether something *could be* done based on some *realization* is speculative, at best, because it does not provide any suggestion or motivation found in the applied references, or in the knowledge generally available to one of ordinary skill in the art, which would have led such a skilled artisan to make modifications to arrive at the claimed invention. As such, it is respectfully submitted that these statements of the Office Action amount to assertions that the claimed features not taught or suggested by the applied documents are within the capabilities of one of ordinary skill in the art. Such a basis, however, cannot be relied upon by itself to establish *prima facie* obviousness. See M.P.E.P. § 2143.01, the section entitled: **“FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS.”**

Additionally, Applicant submits that the motivation is not sound because there is nothing in either of Evanitsky et al. and MacDougall that would suggest that the motivation supplied in the Office Action for combining the references is known outside of Applicant's

disclosure. Such hindsight reasoning is, of course, impermissible. See MPEP §§ 2141 and 2143.

For at least these reasons, Applicant respectfully submits that the rejection of claim 1 fails to establish a *prima facie* case. As such, claim 1 is believed patentable.

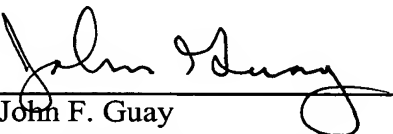
Independent claims 8 and 13 are respectively directed to a method and a computer program product and similarly recite features not disclosed in the Evanitsky et al. and MacDougall patents, whether these documents are considered individually or in any combination. Hence, independent claims 8 and 13 also are believed patentable.

Claims 2, 4-6, 9, 11, 14 and 15 depend from one of claims 1, 8 and 13 are therefore allowable for at least the above reasons, and for the additional features recited.

For all the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections so that issuance of present application will not be further delayed.

Respectfully submitted,

Burns, Doane, Swecker & Mathis, L.L.P.

By:   
John F. Guay  
Registration No. 47,248

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: June 29, 2004